

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:	)	<b>Mail Stop AF</b>
	)	
Isaac K. ELLIOTT et al.	)	Group Art Unit: 2616
	)	
Application No.: 09/879,983	)	Examiner: M. Phan
	)	
Filed: June 14, 2001	)	
	)	
For: SYSTEM AND METHOD FOR	)	
PROVIDING REQUESTED QUALITY	)	
OF SERVICE IN A HYBRID	)	
NETWORK	)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

U.S. Patent and Trademark Office  
Customer Window, Mail Stop AF  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Applicants respectfully request review of the final Office Action, dated July 24, 2006, in view of the remarks below and in conjunction with the Notice of Appeal filed concurrently with this request.

**Remarks** begin on page 2 of this paper.

**REMARKS**

Claims 1-11 are pending in this application.

Claims 1, 5-8, 10, and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over ALDRED et al. (U.S. Patent No. 6,278,693) in view of NAGAMI et al. (U.S. Patent No. 6,515,999). Claims 1-4 and 7-9 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-5 of U.S. Patent No. 6,335,927. Applicants respectfully request review of the final rejection based on the reasons summarized below.

REJECTION UNDER 35 U.S.C. § 103(a) BASED ON  
ALDRED ET AL. AND NAGAMI ET AL.

The rejection of claims 1, 5-8, 10, and 11 contains factual deficiencies.

As to claims 1, 5-8, 10, and 11, Applicants submit that ALDRED et al. and NAGAMI et al. are not prior art with respect to the present application (see, for example, the arguments at pages 2-3 of the Request for Reconsideration, filed May 25, 2006, referred to hereinafter as the "Request for Reconsideration"). The present application is a continuation of U.S. Patent Application No. 08/751,917, filed November 18, 1996. Thus, the effective filing of the present application is November 18, 1996.

ALDRED et al. was filed on March 24, 1997, which is after Applicants' effective filing date. Applicants note that the Examiner may not rely on the benefit of the filing date of ALDRED et al.'s foreign application for prior art purposes (see, for example, M.P.E.P. §§ 706.02(f)(1) and 2136.03). Thus, ALDRED et al. is not prior art under 35 U.S.C. § 103(a) with respect to the present application.

NAGAMI et al. was filed on April 1, 1997, which is after Applicants' effective filing date. Applicants note that the Examiner may not rely on the benefit of the filing date of NAGAMI et al.'s foreign application for prior art purposes (see, for example, M.P.E.P. §§

706.02(f)(1) and 2136.03). Thus, NAGAMI et al. is not prior art under 35 U.S.C. § 103(a) with respect to the present application.

With respect to the above arguments, the Examiner alleges:

although a publication of, or a U.S. Patent issued from, an international application may not have a 35 U.S.C. 102(e) date at all, or may have a 35 U.S.C. 102(e) date that is after the effective filing date of the application being examined (so it is not "prior art"), the corresponding WIPO publication of an international application may have an earlier 35 U.S.C. 102(a) or (b) date

(final Office Action, pg. 2). Regardless of the veracity of the Examiner's statement, Applicants submit that the Examiner has provided no evidence of WIPO publications of the ALDRED et al. and NAGAMI et al. patents that pre-date Applicants' effective filing date.

For a reference to be used in a 35 U.S.C. § 103 rejection, the reference must qualify as prior art under 35 U.S.C. § 102(a), 102(b), or 102(e). ALDRED et al. and NAGAMI et al. do not qualify as prior art any of these sections of 35 U.S.C. § 102.

With regard to 35 U.S.C. § 102(a), there is no evidence that ALDRED et al. and NAGAMI et al. were known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent. Thus, ALDRED et al. and NAGAMI et al. do not qualify as prior art under 35 U.S.C. § 102(a).

With regard to 35 U.S.C. § 102(b), ALDRED et al. and NAGAMI et al. were patented on August 21, 2001 and February 4, 2003, respectively. Therefore, ALDRED et al. and NAGAMI et al. were not patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to Applicants' effective filing date of November 18, 1996. Thus, ALDRED et al. and NAGAMI et al. do not qualify as prior art under 35 U.S.C. § 102(b).

With regard to 35 U.S.C. § 102(e), as described above, ALDRED et al. and NAGAMI et al. are not applications for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, and ALDRED et al. and NAGAMI et al. are also not patents granted on applications for patent by another filed in the United States before the invention by the applicant for patent. Thus, ALDRED et al. and NAGAMI et al. do not qualify as prior art under 35 U.S.C. § 102(e).

Because ALDRED et al. and NAGAMI et al. do not qualify as prior art under any of the above sections of 35 U.S.C. § 102, ALDRED et al. and NAGAMI et al. cannot be used in a rejection under 35 U.S.C. § 103. Thus, any rejection under 35 U.S.C. § 103 based on ALDRED et al. and NAGAMI et al. is improper.

For at least the foregoing reasons, Applicants respectfully request that the rejection of claims 1, 5-8, 10, and 11 under 35 U.S.C. § 103(a) based on ALDRED et al. and NAGAMI et al. be reconsidered and withdrawn.

#### OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

The rejection of claims 1-4 and 7-9 under the judicially created doctrine of obviousness-type double patenting contains factual deficiencies (see, for example, pages 3-4 of the Request for Reconsideration). Applicants filed a Terminal Disclaimer on August 15, 2005, in response to this same rejection in the Office Action, dated May 16, 2005. The final Office Action, dated November 8, 2005, indicates that the Terminal Disclaimer has been accepted by the Patent Office (final Office Action, pg. 2). The Terminal Disclaimer acts to overcome the double patenting rejection. Yet, the Examiner continues to maintain the double patenting rejection of claims 1-4 and 7-9. Applicants submit that the double patenting rejection is moot in light of the timely filed Terminal Disclaimer.

Accordingly, Applicants respectfully request that the double patenting rejection of claims 1-4 and 7-9 be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants submit that clear factual deficiencies exist with respect to the rejections of claims 1-11. Therefore, Applicants respectfully request withdrawal of the outstanding rejection and the timely allowance of this application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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